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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,962	11/25/2003	Robert M. Herrin	7703.26	5936

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EXAMINER

HARMON, CHRISTOPHER R

ART UNIT PAPER NUMBER

3721

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,962

Applicant(s)

HERRIN, ROBERT M.

Examiner

Christopher R. Harmon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 20-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 48-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 46-47 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The previously examined invention and the newly claimed invention are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of claims 46-47 has separate utility such as folding more the side walls of the blank by rotating the second folding arm with an axis generally perpendicular to the first folding arm. See MPEP § 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 46-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 and 48-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Limitations such as “moving thereby and folding portions thereof” (claim 1, line 7; claim 8, line 8; claim 48, line 7; claim 51, line 9) are confusing as to whether the forming rail is being referred to or the blank. Furthermore, the second position (claim 1, lines 3+; claim 8, line 3; claim 48, line 3, claim 51, line 6) is confusing as it is described as “through a biasing...and a driving of the blank therefrom”; the limitation “therefrom” is unclear whether it describes the first or the second position and where exactly is the second position as the limitation describes the movement of the platen. “the side walls” (claim 1, line 8) lacks proper antecedent basis. “allowing the platen to move thereby along a path of the platen” is confusing and indefinite. Note that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990).

Claim 4, line 2 contains the limitation “carried upstream” this is confusing as to how the applicator is “carried”.

Claim 48, line 5 “thereof” is confusing.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tharpe, Jr et al. (US-5,971,906).

Tharpe, Jr et al show an apparatus comprising a platen 212, a forming rails 210, a first folding arm 218, compression plate 400 with fixed plate 420 that forms a passage there between and a second folding arm 412 for biasing against the portion of the formed tray through the passage. The in-feed conveyor is read on conveyor 16. Since conveyor 16 is a horizontal conveyor, the conveyor will hold a surface of the blank against a surface of the conveyor. Drive pneumatic means 220 are used for driving the platen from a first position above the blank to a biasing position for the initial folding position. The plate 212 has a rectangular portion to fold the front and rear panels fsl, rsl perpendicular to front and rear panels fl, rl. Tharpe, Jr et al show folding rails 226, 230, 210, 228 as shown in figure 11 to fold the side portions, end portions and edge portions as claimed. The locking arm is read on element 60. Inherently, the drive devices must have some controller to synchronize the movements. Tharpe, Jr et al also show adhesive applying means 310 as claimed. The frame as claimed is read on elements 412.

Regarding claims 15-16, 18, 19, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See ex parte Thibault, 164 USPQ 666, 667 (Bd App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d

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996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963) Regarding newly amended limitation of the first folding arm being positioned proximate the distal portion of the forming rail and downstream the proximal portion, the folding arm 218 of Tharpe, Jr et al comprise of means 226, 228, 230. Examiner interprets second downstream element 228 as being the first folding arm that is downstream forming rail 210 as shown in figs 1, 11. The biasing effect is created with pressing platen 212. Tharpe, Jr et al is creating the partial folding with the movement of the platen with folding means 218. Tharpe, Jr et al do not disclose whether or not element 228 is movably positioned as claimed; however, Tharpe, Jr et al show the second folding arm 412 as being moveable to create folds.

It would have been obvious to one of ordinary skill in the art to make the first arm 228 moveable in Tharpe, Jr et al as taught by the second folding arm in Tharpe, Jr et al as a matter of engineering design choice to create a desired fold if element 212 was not moveable.

Tharpe, Jr et al do not show beveled edges as claimed or a surface with depressions as claimed. The examiner already took official notice that it is well known in the art to use beveled edges or to have a surface with depressions for reducing the frictional contacting surface in a previous office action and since applicant did not traverse the official notice assertion, this is admitted as prior art in accordance with MPEP 2144.03(c).

Response to Arguments

6. Applicant's arguments with respect to claims *supra* have been considered but are not persuasive.

Note that the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The level of one of ordinary skill in the art is deemed capable of making the modifications as discussed *supra*.

The Affidavits under 37 CFR 1.132 filed 4/6/06 are insufficient to overcome the rejection of claims 1-19 based upon Tharpe, Jr. as set forth in the last Office action because: the inventor (Herrin) has an inherent interest in the application that cannot be ignored. Mr. Tharpe, Jr. is recognized as a joint inventor with Mr. Herrin on other patent applications as well as U.S. Patents e.g. US 6,315,022, US 6,309,487, which is evidence of a bias in the instant application (not a non-interested third party).

Furthermore the claims as previously presented have been amended presenting problems with determining the scope of the claims, as stated *supra*. As inventors in the field, Herrin and Tharpe, Jr. are recognized as having expertise within the field, however this is not pertinent to claim interpretation.

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Regarding the common knowledge modification previously taken (Official Notice), the traversal is untimely therefore not considered. However note for future application, in order to adequately traverse such a finding (of OFFICIAL NOTICE), an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See MPEP 2144.03(c) and also Chevenard, 139 F.2d at 713, 60 USPQ at 241. Merely stating that beveled corners provided as claimed perform a required task does not rise to the level of contestation of the statement it is well known in the art to use beveled edges or to have a surface with depressions for reducing the frictional contacting surface.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Rinaidi I. Rada', followed by a horizontal line.

Rinaidi I. Rada
Supervisory Patent Examiner
Group 3700